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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/442,819	11/18/1999	WARREN F. SCHMALENBERGER	SCHC,002	6427

7590 05/25/2007
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EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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05/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/442,819

Applicant(s)

SCHMALENBERGER, WARREN F.

Examiner

Daniel S. Felten

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt of the March 05, 2007 amendment is acknowledged. Claims 1-32 are pending in the application and are presented to be examined upon their merits.

Status of the Claims

2. In response to Applicant's remarks regarding the status of the claims, claims 1-32 are currently rejected under 103(a) in view of Reilly, F.K. as cited in office actions dated April 13, 2006, rejecting claims 1-27 and November 22, 2006 rejecting claims 28-32.

Response to Arguments

3. Applicant's arguments filed March 05, 2007 have been fully considered but they are not persuasive. In response to applicant's arguments in regards to the 35 U.S.C. § 101 rejection of claims 1-32, the recitation of a *computer implemented* method has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

4. In regards to the 35 U.S.C. § 103(a) rejection of claims 28-32 it is maintained that the office action of April 21, 2006 provides reasoning for the rejection of the claims. It is respectfully submitted to the applicant that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular

Art Unit: 3693

problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Reilly suggests that countries have developed composite series which reflect the performance of all securities and that the capital markets. The reference is not being cited merely for the teachings of individual indexes, but for what the reference teaches based upon the prior art as a whole, that being, that world capital markets are becoming more integrated (as e.g., Solomon Brothers Indexes and Merrill Lynch's index, ect.,). Thus an artisan of ordinary skill in the art would have previously been familiar with conventional art concepts like "diversification," "balance funds," and the combination of indexes based upon various fund types (e.g. Lipper Balanced index) to provide a more comprehensive international index. Thus the rejections are again provided below for the applicant's convenience.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly, F.K., "Investment Analysis and Portfolio Management", 3rd Ed. The Dryden Press, Copyright 1989, pp. 165-170.

--Re claims, 1-21 and 24-27, Reilly anticipates the inventive concept of the applicant's invention by providing a comprehensive list of combined market sector indexes. In particular,

Art Unit: 3693

Reilly discloses "*Salomon Brothers International Bond and Money Market and Performance Indexes*" which provides a comprehensive measure of the total return of high quality securities in mayor international sectors of the bond and money markets that is market-value weighted (see Reilly, page 165).

--Reilly also discloses the "*Merrill Lynch-Willshire Capital Market Index*" which is a *market value-weighted index* that was created to measure the total return performance of the combined stock and bond indexes (see Reilly page 165).

--Commenting on the importance of "diversity," Reilly suggests that countries have developed composite series which reflect the performance of *all* securities, and that world capital markets are becoming *integrated*--leading to world capital indexes (see Reilly, "*Composite Security Market Series*"). It would have therefore been obvious for an artisan of ordinary skill in the art to integrate the *stock index* of Merrill Lynch into the Solomon Brother's index and/or the *money market index* of Salomon Brothers into Merrill Lynch because one of ordinary skill in the art would have been familiar with the notoriously old and well known concept of "*diversification*" and thus have recognized the importance of diversification to provide a more integrated and comprehensive measure of the performance of capital markets of a country and/or various other countries. Thus the integration of various indexes would have been an obvious expedient well within the ordinary skill of the art.

Furthermore, an artisan of ordinary skill in the art would be familiar with the concept of a "balanced fund" or "asset allocation fund" which characteristically invests its assets into money markets, bonds, preferred stock and common stock with the intention to provide both growth and income. Thus, since it is known in the art to provide indexes based upon various fund types,

Art Unit: 3693

a balanced fund index (e.g. *Lipper Balanced Fund Index*) would be an obvious expedient well within the ordinary skill in the art.

Re claims 22 and 23: Reilly fails to disclose, as in claims 22 and 23, that the indexes are calculated via a computer and encoded in the memory of a computer. However computers are widely used making business calculations and thus OFFICIAL NOTICE is taken for using computers for creating indexes.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3693

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742.

The examiner can normally be reached on Flex.

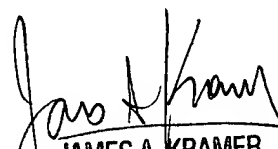
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel S Felten
Examiner
Art Unit 3693

DSF
10/21/2007



5/23/07
JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600